

REMARKS

I. Status of Claims

Claims 1-19 are pending. Claims 1-19 have been allowed. Claims 20-34 were cancelled in an earlier reply. Claims 35-64 are added herein. No claims from the original patent are amended or cancelled. A charge form for the fee for additional claims is enclosed.

II. Entry as Matter of Right because Prosecution Not Closed

Applicant believes that prosecution has not been closed because neither a final action nor a Notice of Allowance and Issue Fee Due has been issued. Therefore, Applicant believes the claim amendments submitted herein should be entered as a matter of right pursuant to 37 CFR §1.111.

III. Alternatively, Entry as Matter of Right because Prosecution Reopened

If the claim amendments are not entered as a matter of right because prosecution has been closed, Applicant argues in the alternative that the prosecution has been reopened as indicated it would be in the Withdrawal from Issue dated July 20, 2006 and the office action dated July 21. As such, the claim amendments submitted herein should be entered as a matter of right pursuant to 37 CFR §1.111

IV. Alternatively, Entry as Matter of Examiner's Discretion

If the claim amendments are not entered as a matter of right, Applicant argues in the alternative that the claim amendments can be entered at the Examiner's discretion under 37 CFR §1.116 because the amendments should be treated as amendments after final. The claim amendments herein put the application in better form for allowance or appeal.

V. Alternatively, Entry as Matter of Request for Continuing Examination

If the claims are not entered as a matter of right or under the Examiner's discretion, and the prosecution has been deemed closed and not yet reopened, Applicant requests continued examination under 37 CFR §1.114 and requests that the claim amendments submitted herein be entered. A charge form for the fee for continued examination is enclosed.

VI. Claims 20-24

Claims 20-34 were cancelled by Applicant in a response to an office action dated September 9, 2004. However, Applicant cancelled claims 20-34 at that time not because he thought the obviousness objections could not be overcome, but in order to expedite the allowance of the reissue application, which had been pending for nearly three years, despite being a special application and in litigation. Applicant believes claims 20-34 were allowable then, and now, without amendment, over the rejections set forth in that office action because, *et alia*, each of the three cited patents teach away from the laser light being visible to the practitioner due to inherent structural limitations of the disclosed devices. If the claims are rejected again for obviousness, Applicant reserves the right to traverse such rejection with legal and factual arguments.

Therefore, Applicant presents claims 20-34 again herein as claims 35-49. Support in the specification for these claims was presented in the original reissue application dated November 6, 2001 and is incorporated herein by reference.

VII. Claims 50-64

Applicant submits new claims 50-64. Applicant believes that the specification supports the added claims, and respectfully requests that the '096 patent be corrected to add these claims. The attorney preparing the original application failed to appreciate the full scope of the invention. The nature of the broadening with these claims relates to the electrical circuit for controlling the period of time the laser light is generated and the optical arrangement. These broadening claims can be presented after two years from the grant of the original patent because they are filed in a broadening reissue application that

was filed within two years from grant. MPEP §1412.03. *See In re Doll*, 419 F. 2d 925, 928, 164 USPQ 218, 220 (CCPA 1970).

Support is found in the specification for these claim amendments as follows: The patented invention is compact in size. *See* the Title and column 1, lines 60-61 of US patent 6,013,096 (hereinafter “the ‘096 patent”). It is freely movable and easy to maneuver by hand. *See* col. 2, line 63.

The device includes a laser. *See* col. 1, line 62; col. 2, line 2. As known to persons skilled in the art, a semiconductor diode is only one embodiment of the laser. *See* col. 4, line 26. An optical arrangement is disposed in the wand for receiving the generated beam of laser light from the laser and transforming the laser light into a line of laser light. *See* col. 2, line 5; col. 3, line 65 – col. 4, line 3. The laser light is visible to the user as the wand is moved during treatment. *See* col. 4, lines 47-50; Claim 1 of original patent.

The device includes an electrical circuit for controlling a period of time said beam of laser light is generated. *See* col. 2, lines 42-44. The electric circuit has switches for controlling a period of time the laser light is generated. *See* col. 5, line 2-3; Table 1; col. 6, line 53. The switches may be push buttons. *Id.*

The device includes means for transforming the laser light into the line of laser light. *See* col. 3, lines 49-52. The means for transforming the laser light into a line may be an optical arrangement. col. 3, line 65 – col. 4, line 3. As known to persons of skill in the art, an optical arrangement may comprise optical devices such as mirrors, lenses, filters, gratings and prisms. *See*, e.g., the patents listed on Exhibit A. The preferred embodiment of the device uses two optical devices, namely a collimating lens and a prism. *See* col. 4, lines 33-34. The means for transforming the laser light may be a mechanical arrangement. *See* col. 4, lines 41-43.

Preferably a battery is used to supply electrical power to the laser beam generating means. *See* col. 2, line 34. The battery can be any commercially-available d.c. battery. *See* col. 5, line 63. The specification supports a battery operably attached to the laser to power it. *See* col. 2, lines 12-14; col. 4, lines 12-17. The specification does not require that the battery reside in an external housing separate from the wand. If a small enough battery is used, or alternatively a large enough wand, the battery can fit inside the

wand cavity, making a shorter connection to the laser module and thus a smaller size device. *See* col. 4, lines 20-22. The added claims reflect moving the battery to the wand.

Further, the specification does not indicate that the wand must move relative to a housing to achieve the objectives of the invention. The pertinent object here is to move the wand relative to the patient. *See* col. 1, lines 62-65; col. 4, line 48. As originally claimed, the means for supplying electrical power may reside in a housing external to the wand so that, in effect the wand moves relative to the housing when moving relative to the patient. However, the object of freely moving the wand relative to the patient can be achieved without reference to the housing, particularly if the power means is moved within the wand.

VIII. Conclusion

Applicant believes the claim amendments herein should be entered. Applicant believes that no formalities are outstanding and that the reissue application is form for issuance.

Date:

8/10/2006

Respectfully submitted,


Sandra L. Etherton
Attorney for Applicant
Registration No. 36,982

Customer Number 33354
Etherton Law Group, LLC
5555 East Van Buren Street
Suite 100
Phoenix, AZ 85008
tel: 602-681-3331
fax: 602-681-3339

Exhibit A

Selection of U.S. Patents Disclosing Optical Arrangements

U.S. Patent No.

5,071,416
5,091,626
5,336,215
5,554,029
5,786,924
5,822,345
5,825,551
5,200,966
4,711,542
4,728,770
4,776,687
4,642,114
4,309,998